

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the reasons that follow.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented with appropriately defined status identifiers.

Claims 1, 10 and 23 are currently amended to provide additional clarity. Because these amendments do not introduce new matter and place the claims in condition for allowance, entry thereof by the PTO is respectfully requested. Upon entry of this Amendment, claims 1, 2, 4-15 and 17-27 will remain pending in this application.

Claim rejection under 35 U.S.C. § 112, second paragraph

On page 2 of the Action, claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite with respect to the term “includes”. According to the PTO, it is unclear what other components the first polymer and the second polymer can contain. Applicants respectfully submit that an ordinary artisan would understand that each of the first polymer and the second polymer can comprise other component(s) in addition to the component recited for the respective polymer. Applicants also refer to Applicants’ arguments made in the previous response filed on February 8, 2008. However, solely to expedite prosecution of the application, Applicants have amended the term “includes” to “is”. Accordingly, Applicants respectfully request withdrawal of the indefiniteness rejection.

Claim rejection under 35 U.S.C. § 103(a)

On page 4 of the Action, all of the claims under consideration are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over US 6,395,326 to Castro *et al.* (“Castro”).

To establish a *prima facie* case of obviousness, the PTO must provide evidence or well-grounded technical reasoning establishing that every feature of a claimed invention was part of the prior art or otherwise would have been known to an ordinary artisan prior to the time the claimed invention was made.

Applicants respectfully submit that the PTO has not established a *prima facie* case of obviousness against any of the claims under consideration because the PTO has not provided evidence or well-grounded technical reasoning establishing that every feature of any of these claims was part of the prior art or otherwise would have been known to an ordinary artisan. For example, the proffered evidence Castro does not teach or suggest a medical article comprising (1) a biologically degradable AB block copolymer capable of absorbing, at equilibrium and at room temperature, about 5% or more water by mass of the AB block copolymer and (2) a biologically degradable polymer having less than 5% water by mass of the biologically degradable polymer. All of these features are recited directly or indirectly in each of the claims under consideration.

Applicants refer to Applicants' arguments made in the 2/8/2008 response. In addition, Applicants make the following arguments in response to the PTO's assertions in the current Office Action.

The PTO essentially makes an inherency argument in support of the obviousness rejection over Castro. The PTO asserts that "if the prior art teaches the *identical* chemical structure, the properties applicant discloses and/or claims are *necessarily* present" (Action, page 6, emphases added). Applicants respectfully submit that Castro does not teach a biodegradable AB block copolymer or a biodegradable polymer having the *identical* chemical structure as that claimed. Castro merely teaches that "[s]uitable polymeric materials can include, but are not limited to" a long list of polymers and copolymers, including "(PBT)-co-PEG" and "PCL-co-PEG" (column 12, lines 49-67). An ordinary artisan would understand that block copolymers formed from the same kinds of monomers (e.g., PEG and PCL) do *not* necessarily have the identical chemical structure. Rather, their exact chemical structure depends on various factors such as, e.g., the ratio of the different kinds of monomers, the number of monomers in the various blocks, and the arrangement of the blocks.

Since block copolymers formed from the same kinds of monomers do not necessarily have the identical chemical structure, such copolymers do not necessarily have identical physical and chemical properties. For example, the water-absorbing ability of a PEG-PCL block copolymer depends on various factors such as the ratio of the more hydrophilic PEG monomer units to the more hydrophobic PCL monomer units, as explained in the 2/8/2008 response.

In support of its apparent inherency argument, the PTO also asserts:

Instant claim 10 indicates that m , n , l , K , r are positive integers. A positive integer would be one. Therefore as long as an AB block polymer of PCL and PEG is present it would meet the limitation of that claim and would necessarily be able to absorb water as claimed by the Applicant. (Action, page 7)

Applicants respectfully point out that the variables m , n , l and K (the variable r has been deleted from the claims) must have values such that the AB block copolymer is capable of absorbing, at equilibrium and at room temperature, about 5% or more water by mass of the AB block copolymer. Not all, e.g., PEG-PCL block copolymers have a water-absorbing ability as claimed because the properties of block copolymers depend on various factors such as, e.g., the ratio of the different kinds of monomers, the number of monomers in the various blocks, and the arrangement of the blocks.

The PTO also asserts that “capable” of absorbing water “means [the claimed AB block copolymer] has the ability to absorb the water; it does not necessarily have to absorb water” (Action, page 7). As claimed, the AB block copolymer must be able to absorb, at equilibrium and at room temperature, about 5% or more water by mass of the AB block copolymer. There is no suggestion in Castro’s general teachings that any of the copolymers disclosed therein, even if in AB block form for the sake of argument, is capable of absorbing, at equilibrium and at room temperature, about 5% or more water by mass of the block copolymer.

In sum, Castro’s general disclosure that “[s]uitable polymeric materials can include, but are not limited to” a long list of polymers and copolymers does not teach or suggest (1) a biologically degradable AB block copolymer capable of absorbing, at equilibrium and at room temperature, about 5% or more water by mass of the AB block copolymer, or (2) a biologically degradable polymer having less than 5% water by mass of the biologically degradable polymer. Further, this general disclosure in Castro does not teach or suggest the combination of (1) and (2), which combination is recited directly or indirectly in each of the claims under consideration.

Because the PTO has not provided evidence or well-grounded technical reasoning establishing that every feature of any of the claims under consideration was part of the prior art or otherwise would have been known to an ordinary artisan, the PTO has not established a *prima facie* case of obviousness against any of these claims. Accordingly, Applicants respectfully request withdrawal of the obviousness rejection over Castro.

Conclusion

The present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 07-1850. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-1850. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 07-1850.

Respectfully submitted,

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SQUIRE, SANDERS & DEMPSEY LLP

Customer Number: **45159**

Telephone: (415) 954-0390

Facsimile: (415) 393-9887

By /Tam Q. Dinh, Reg. # 55115/

Tam Q. Dinh, Ph.D., Esq.
Attorney for Applicants
Registration No. 55,115

Zhaoyang Li, Ph.D., Esq.
Attorney for Applicants
Registration No. 46,872